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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,026

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Jun Kakuta

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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

FEARER, MARK D

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/766,026	<b>Applicant(s)</b> KAKUTA ET AL.	
	<b>Examiner</b> MARK D. FEARER	<b>Art Unit</b> 2443	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's Amendment filed 08 October 2010 is acknowledged.
2. Claims 1, 9 and 11 have been amended.
3. Claims 1-11 are pending in the present application.
4. FINAL rejection of 11 May 2010 is withdrawn.
5. Claims 9-10 are allowed.

### ***Specification***

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 2-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's Specification lacks the written description for the limitation of 'restriction data'.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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**10.** Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**11.** In claim 1, the claim limitations use the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. Claims 2-6 are rejected for either including further “means for” limitations or because of their dependencies.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly not modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does not wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

***Claim Rejections - 35 USC § 103***

**12.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**13.** Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (US 6842604 B1) in view of Tuomi (US 20040093418 A1).

Consider claim 11. Cook et al. discloses a method for delivering to a plurality of user terminals, comprising: receiving received information from a user terminal (Cook et al., column 2 lines 14-36); obtaining identification information identifying a user terminal

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to which the received information is to be delivered, and an index assigned to the received information (Cook et al., column 3 line 49 – column 4 line 4); obtaining profile information from a user terminal requiring delivery of the received information (Cook et al., column 3 line 49 – column 4 line 4); storing the profile information according to the identification information at each index; updating the received information (Cook et al., column 4 line 52 – column 5 line 3); and receiving a determined order of delivery of the updated information to the plurality of the user terminals at each index when the received information is updated (Cook et al., column 4 lines 33 – 51).

However, Cook et al. does not explicitly teach a system and method comprising a plurality of second user terminals for delivering updated information data according to profile data.

Tuomi discloses a system and method of update of subscriber profiles in a communication system comprising a plurality of second user terminals for delivering updated information data according to profile data.

[Claim 1] A method for maintaining subscriber profiles in a first communication network where subscriber-specific data services are provided for terminals operated by users, the method comprising the steps of transmitting a location update request from the first communication network to a mobile network, the location update request being such that it triggers in the mobile network the sending of a first response, which includes information relating to a subscriber, receiving the first response in the first communication network, and updating the profile of the subscriber in the first communication network by means of the information received in the first response from the mobile network.

Cook et al. discloses a prior art apparatus for delivering to a plurality of user terminals, comprising: receiving received information from a user terminal; obtaining identification information identifying a user terminal to which the received information is

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to be delivered, and an index assigned to the received information; obtaining profile information from a user terminal requiring delivery of the received information; storing the profile information according to the identification information at each index; updating the received information; and receiving a determined order of delivery of the updated information to the plurality of the user terminals at each index when the received information is updated upon which the claimed invention can be seen as an improvement.

Tuomi teaches a prior art comparable system and method of update of subscriber profiles in a communication system comprising a plurality of second user terminals for delivering updated information data according to profile data.

Thus, the manner of enhancing a particular device (system and method of update of subscriber profiles in a communication system comprising a plurality of second user terminals for delivering updated information data according to profile data) was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in Tuomi. Accordingly, one of ordinary skill in the art would have been capable of applying this known improvement technique in the same manner to the prior art apparatus for delivering to a plurality of user terminals, comprising: receiving received information from a user terminal; obtaining identification information identifying a user terminal to which the received information is to be delivered, and an index assigned to the received information; obtaining profile information from a user terminal requiring delivery of the received information; storing the profile information according to the identification information at each index; updating

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the received information; and receiving a determined order of delivery of the updated information to the plurality of the user terminals at each index when the received information is updated of Cook et al. and the results would have been predictable to one of ordinary skill in the art, namely, one skilled in the art would have readily recognized a system and method of updating subscriber profiles.

***Allowable Subject Matter***

**14.** Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an Examiner's statement of reasons for allowance:

**15.** Consider claims 9-10. None of the prior arts of record teach or suggest a method of information delivery comprising: receiving information from a user terminal; obtaining identification information identifying a user terminal to which the information is to be delivered, and an index assigned to the information; obtaining profile information from a user terminal requiring delivery of the information; storing the profile information according to the identification information at each index; receiving updated information updating the information; and determining an order of a plurality of the user terminals to receive information assigned at each index for delivering the updated information when the information is updated, the updated information being delivered according to the order.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably



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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance.

***Response to Arguments***

**16.** Applicant's arguments filed 08 October 2010 with respect to claim 11 have been considered but are not persuasive.

Applicant argues that Cook et al., as modified by Tuomi, does not teach or suggest receiving a determined order of the plurality of the user terminals to receive information assigned at each index for delivering the updated information date when the received information is updated.

Examiner respectfully disagrees. Cook et al. teaches a system and method of distributing content from a central host computer to a plurality of consumers (column 4 lines 50-56), interpreted to read on the plurality of user terminals, an event scheduler (column 4 line 22) and track identification codes (column 4 line 3), interpreted to read on information index, and a distributor that schedules delivery to the consumers when as events occur (column 4 lines 42-51), interpreted to read on delivering the updated information date when the received information is updated.

***Conclusion***

**17.** Any response to this Office Action should be faxed to (571) 273-8300 or mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

**Customer Service Window**

Randolph Building  
401 Dulany Street  
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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark Fearer whose telephone number is (571) 270-1770. The Examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Mark Fearer  
/M.D.F./  
October 27, 2010

/J Bret Dennison/  
Primary Examiner, Art Unit 2443